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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,413	01/28/2004	Carnell K. Dennis	09385-00002-US	2914
23416	7590	11/23/2005	EXAMINER	
CONNOLLY BOVE LODGE & HUTZ, LLP			DAWSON, GLENN K	
P O BOX 2207			ART UNIT	
WILMINGTON, DE 19899			PAPER NUMBER	
			3731	

DATE MAILED: 11/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/766,413

Applicant(s)

DENNIS, CARNELL K.

Examiner

Glenn K. Dawson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19-23 is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-14 and 16-18 is/are rejected.
- 7) ☒ Claim(s) 6, 7 and 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-5,8 and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wright-4657010 in view of Yant-2382364.

Wright discloses a mask having an upper portion and a lower portion. A plurality of accordion folds extends from the top portion towards the bottom portion. A strap 26 (adjustment member) with holes accepts snaps on the mask to hold the folds in different configurations thus changing the width of the mask.

As the width of the mask has a "length" or distance, the examiner contends that adjusting the adjustment member obtains a desired "length (or distance) of the mask. Additionally, Wright discloses a bottom of the mask has adjustment members to change the effective length of the mask. Snaps/apertures or Velcro patches are disclosed, but other means could be used as well. Yant discloses that it was known to provide accordion folds on a facemask in order to change the length of the mask. It would have been obvious to have used the accordion folds of Yant instead of the two-part system of Wright, as it would prevent possible loss of one of the components of the mask as they are completely separable. Additionally, the examiner contends that since Wright teaches of using a strap/apertures system in the top of the mask to hold folds in an orientation, it would have been obvious to use such a system on the bottom of the mask to hold those folds in an orientation, since Wright already teaches that such a structure is usable to retain the folds in a position.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wright-'010 in view of White, et al.-'755, as applied to claim 1 above, and further in view of Wortz, et al.-3441020.

Wright as modified by Yant makes obvious the invention as claimed with the exception of the material of the mask. Wortz discloses a facemask made out of polyethylene. It would have been obvious to have made the mask of Wright out of polyethylene, as this material has sufficient rigidity to maintain its configuration, yet is sufficiently resilient to enable the mask to seal properly against different facial contours.

Claims 14 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wright-4657010 in view of Yant-'364.

Wright discloses the method as claimed with the exception of having accordion folds and using an adjustment member to hold the folds in a position to obtain a desired length along the vertical extent of the mask. Wright does disclose a plurality of accordion folds extending from the top portion towards the bottom portion. A strap 26 (adjustment member) with holes accepts snaps on the mask to hold the folds in different configurations thus changing the width of the mask, not the length along the vertical extent of the mask.

Yant discloses accordion folds for changing the length of a mask. However, no adjustment member is disclosed. Exchanging the expansion system of Wright with that of Yant incorporating folds into the bottom portion of the mask would have been obvious for the same reasons noted above. Using an adjustment member designed like 26 in Wright to hold these accordion folds in an orientation would have been obvious in order to hold the mask in an orientation suitable for any particular patient. That is to say, in order to prevent the mask from inadvertently becoming too large or small for the user by virtue of the accordion folds expanding or contracting.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s).

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See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5,8-14, and 16-18 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-35 of U.S. Patent No. 6851428. Although the conflicting claims are not identical, they are not patentably distinct from each other because the application claims are either broader than those of the patent, or include obvious modifications, such as, the exact placement of the folds being between an upper portion and a lower portion, which is obvious because the delineations of these portions is arbitrary; and the exhaust port or apertures and the inlet, which are notoriously well-known in the art of respiratory masks.

Response to Arguments

Applicant's arguments filed 08-22-2005 have been fully considered but they are not persuasive.

White has a rather complicated mechanism for adjusting the length of the mask. Yant discloses a much more simplified mechanism (accordion folds) for accomplishing the same task. It would be nothing more than a substitution of one sizing mechanism for another. The only additional modification is the adjustment member.

However, since Wright already discloses such a member for holding the accordion folds changing the "width" of the mask, it would have been obvious to have employed the same type of device to hold the vertical accordion folds taught by Yant in a particular orientation for the reasons noted above.

Allowable Subject Matter

Claims 19-23 are allowed.

Claims 6,7 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Glenn K. Dawson whose telephone number is 703-308-4304. The examiner can normally be reached on M-Th 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on 703-308-2154. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Glenn K Dawson
Primary Examiner
Art Unit 3731

Gkd
24 June 2005